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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,305	05/26/2000	Anthony A. Shah-Nazaroff	116538-153394	9133

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SCHWABE, WILLIAMSON & WYATT, P.C.  
PACWEST CENTER, SUITE 1900  
1211 S.W. FIFTH AVE.  
PORTLAND, OR 97204

EXAMINER
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SALCE, JASON P

ART UNIT	PAPER NUMBER
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2421

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01/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/580,305	<b>Applicant(s)</b> SHAH-NAZAROFF ET AL.	
	<b>Examiner</b> Jason P. Salce	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-16,18-20,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-16,18-20,25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 10/24/2008 have been fully considered but they are not persuasive.

Applicant argues that Majeti fails to teach “receiving, by the server system, a selection to buy an upgrade media feature for a programming transmission”.

Applicant further notes that the information is transmitted to the user in tandem with a cable television signal, but one of ordinary skill in the art would never construe such data as an upgraded media feature for a programming transmission as it is neither related to, nor for, the programming transmission. The Examiner respectfully disagrees.

The claim limitations are broad and do not recite that the upgraded media feature is related to the programming transmission. The claim limitations only recite that the upgraded media feature is for a programming transmission. As cited in the previous Office Action, Majeti teaches transmitting the upgraded media feature with additional television programming (**see Column 9, Lines 40-46 of Majeti for transmitting the requested information with additional television programming, which is a programming transmission**). The Examiner further notes that even if the claims recited that the upgraded media feature is related to the programming transmission that this recitation is still broad and that by transmitting the upgraded media feature of Majeti with television programming, Majeti teaches a relation between the upgraded media feature and the programming transmission.

Applicant further notes that as further evidence of this non-existent relationship, Majeti teaches that information provided by the ESP(s) is split from the cable television signal and sent to a personal computer. The Examiner respectfully disagrees.

The claim limitations are broad and do not distinguish any difference between receiving information by both a personal computer and a television receiver. The claims only recite a client system, where Majeti teaches a client system 20 in Figure 1. Again, see the Examiner's rebuttal above for the Examiner's interpretation for the upgraded media feature being for a programming transmission, by transmitting the upgraded media feature with television programming.

Applicant also argues Rothblatt fails to cure this deficiency noted above. See the Examiner's rebuttal above for Majeti teaching the claim limitations.

Applicant also argues that Majeti and Rothblatt also fail to teach or suggest that the feature of automatically coordinating provision, by the server system, of the upgraded media feature for the programming transmission, the programming transmission and upgraded media feature to be provided from the one programming transmission source to the client system via a third communication media. The Examiner respectfully disagrees.

The claim limitations are broad and only recite that, "***the programming transmission AND upgraded media feature to be provided from the one programming transmission source to the client system via a third communication***

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**media**". The claims do not positively recite that both the programming transmission and the upgraded media feature are to be provided from the one programming transmission source, the Examiner has interpreted the claim as only the "upgraded media feature" being provided from the one programming transmission source, because the claim limitation "to be" is unclear in regards to the upgraded media feature being provided from the one programming transmission source or **both** the programming transmission source and the upgraded media feature being provided from the one programming transmission source.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-16, 18-20 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majeti et al. (U.S. Patent No. 5,512,935) in view of Rothblatt (U.S. Patent No. 6,105,060).

Referring to claim 1, Majeti discloses receiving, by a server system (**see server 18 in Figure 1**), a request to receive an upgraded media feature for a programming transmission from a client system via a first communication media (**see Figure 1 and**

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**Column 3, Lines 29-42 for a client system requesting content from “enhanced service providers” over a PSTN communications network 24).**

Majeti also discloses automatically coordinating retrieval, by the server system, of the upgraded media feature for the programming transmission with one of the plurality of programming transmission sources via a second communication media (**see Figure 1 and Column 3, Lines 42-55 for routing the request over telecommunications network 14 and receiving the requested enhanced content from the information/enhanced service providers 10A-10N via the telecommunications network 14**), the first communication media different than the second communication media (**see Figure 1 for the PSTN network 24 being different from the telecommunications network 14**).

Majeti also discloses automatically coordinating provision, by the server system, of the upgraded media feature for the programming transmission, the programming and the upgraded media feature to be provided from the one programming transmission source to the client system via a third communication media (**see Figure 1 and Column 3, Line 55 through Column 4, Line 2 for server/bridging unit 18 transmitting the requested enhanced content over distribution head-ends 30A-30N along with broadcasted television programming**), the third communication media different than the first and second communication media (**see Figure 1 for the cable distribution headends being a different communications media different from the PSTN network 24 and telecommunications network 14**).

Majeti fails to teach that the upgraded media features are purchased by the client.

Rothblatt discloses a backhaul system similar to Majeti that receives requests from a client device for supplemental data, wherein the supplemental data is distributed over a high speed communication network to the client device (**see Figure 1 and Column 16, Lines 33-46**). Rothblatt further discloses that the client device can purchase and be billed for the Internet usage (**see Column 16, Lines 46-48**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify server, as taught by Majeti, to include the accounting functionality, as taught by Rothblatt, for the purpose of providing a low-cost user terminal that allows user to receive satellite-based direct radio broadcast data (e.g. large geographic coverage, good sound quality, high outbound data rates and low cost), as well as bi-directional communication for global, portable Internet/WWW access capability (**see Column 1, Lines 61-67 of Rothblatt**) and also allow the system of Majeti to generate revenue for the requested supplemental data.

Referring to claim 2, Majeti also discloses receiving the selection from an entertainment system (**see Figure 1 for receiving the request from client system 20**), and the programming transmission is provided to the entertainment system with the upgraded feature via the third communication media (**see again Figure 1 and Column 3, Line 55 through Column 4, Line 2 for receiving the requested enhanced content and television programming from the cable distribution networks 10A-10N**).

Referring to claim 3, Rothblatt discloses billing, by the server system, the client system for services performed by the server system (**see the rejection of claim 1**).

Majeti and Rothblatt fail to disclose providing the billing information associated with the client system to the programming transmission source that provided the programming transmission.

The examiner takes Official Notice to the fact that programming transmission sources are well known in the art to receive additional data or services that have been ordered by a client system.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the programming transmission source, as taught by Barker and Rothblatt, to include means for collecting data on what services the client system has ordered, for the purpose of allowing a programming transmission source to customize commercials or television programs to further target the preferences of a viewer.

Referring to claim 4, Rothblatt discloses that the billing is performed according to a billing cycle for transactions during the billing cycle (**see Column 16, Lines 46-48 for billing a customer according to a monthly billing cycle**).

Referring to claim 5, see the rejection of claims 1 and 4.

Referring to claim 6, see the rejection of claim 4.



Referring to claim 8, see the rejection of claim 1.

Referring to claim 9, see the rejection of claims 1 and 4.

Referring to claim 10, see the rejection of claims 1 and 4.

Referring to claim 11, Majeti discloses that the programming transmission is an audio production (**see the rejection of claim 1 and further note that a television production inherently contains an accompanying audio production**).

Referring to claim 12, Majeti discloses that the upgraded media feature is a video upgrade (**see Column 12, Line 58 through Column 13, Line 28**).

Referring to claim 13, Majeti discloses that a transmission source is a cable television source (**see Figure 1 for transmitting enhanced content and television programming through a cable headend 10A**).

Referring to claim 14, see the rejection of claim 1.

Referring to claim 15, see the rejection of claim 3.

Referring to claim 16, see the rejection of claim 5.

Referring to claim 18, see the rejection of claim 1.

Referring to claims 19-20, see the rejection of claims 9-10, respectively.

Referring to claims 25-26, see the rejection of claim 1.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/  
Primary Examiner, Art Unit 2421

Jason P Salce  
Primary Examiner  
Art Unit 2421

January 6, 2009